

REMARKS

Claims 1 through 9, 11 through 27 and 29 are pending in this application. Claims 4, 6, 7, 8, 11, 14, 16, 17 and 29 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claim 10 has been canceled without prejudice or disclaimer of its subject matter. The Applicant appreciates the Examiner's indication of allowance of claims 22-24, 26 and the allowability concerning claims 4, 6-8, 10, 11, 14, 16, 17 and 29.

I. CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 19-21, 25 and 27 rejected under 35 U.S.C. 102(b) as being anticipated by Outlook. The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered

in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

As per claim 19, the Outlook fails to disclose printing the letters corresponding to the image and character data read by said step of reading image and character data.

The Examiner explains in paper no. 9 that Outlook reads on the claim either way, e.g., the letters that are views are printed (see page 117, Fig. 3.55, here the letter is being viewed, then the letter is printed after one clicks on the printer icon) and the letters that are printed are indeed printable if one chooses to preview the letter (see page 121, Fig. 3.59, the preview button).

However, the claim specifically states “printing the letters corresponding to the image and character data read...” In Outlook, however, as the Examiner admits, it is optional upon a user by clicking or not clicking a printer icon, thereby the image read by the user may or may not be printed when the user views the letter. Concerning anticipation, the mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

Moreover, concerning claims 19-21, 25 and 27, the apparatus of the present invention can be automatically connected, without using a Personal Computer (PC), to a mail server through a PSTN to receive electronic letters of many users in each account of the mail server to which the apparatus is connected. The apparatus manages and prints the received electronic letters. Therefore,

the apparatus of the present invention can receive and print electronic letters like a fax machine that receives and prints data. That is, while in Outlook the user should manually connect to the server using a PC, the apparatus of the present invention can be automatically connected to the mail server without intervention of the user, and can receive and print electronic letters without using a PC. Therefore, it is easier to use the present invention than Outlook.

II. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1, 2, 3, 5, 9, 12, 13, 15 and 18 are rejected under 35 USC 103(a) as being unpatentable over No. 5,521,719 to Yamada in view of Outlook. The Applicant respectfully traverses.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In Yamada, when fax data are received, the fax data can be discriminated by identifying a subaddress included in the frame data. Therefore, the fax data can not be classified by a user without the subaddress. Especially, in Yamada, the fax data are received directly from the transmitter by peer-to-peer communication, the fax message included in the received fax data is managed as the electronic mail is managed, and the fax data is only transmitted through a LAN to a printer or mail server. To achieve this, in Yamada, the subaddress should be requested. A common protocol is needed for both sides. That is, in Yamada, the mail server can only be connected through a LAN and the fax data can only be transmitted through a LAN to the mail server, but cannot be transmitted from the mail server. However, the apparatus of the present invention is connected to the account of a mail server not through a LAN, but through a PSTN to receive the electronic letter and can classify the electronic mail of users according to the previously input mail account. Therefore, the present invention differs from Yamada and from Yamada in view of Outlook.

Claim 1 was amended to include claim 10 as suggested by the examiner since claim 10 is allowable. The examiner had stated that claim 10 is objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Therefore, claim 10 was included in the base claim 1 and claim 10 cancelled. Therefore, claims 1, 2, 3, 5, 9, 12, 13, 15 and 18 should be allowable.


III. ALLOWABLE SUBJECT MATTER

The examiner stated that Claims 4, 6-8, 10, 11, 14, 16, 17 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Following the advice of the examiner, the claims were rewritten in independent form including all of the limitation of the base claim and any intervening claims. Therefore, the objected to claims should be allowed.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$774.00 is incurred by this Amendment for the addition of nine (9) independent claims above six (6). Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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